REMARKS

This amendment is filed in response to the Office Action dated November 4, 2005. This amendment is filed with a Request for Retroactive Extension of Time and authorization to charge Deposit Account No. 50-0951 for the appropriate fees.

Claims 1-22 are pending in the present application. By this amendment, claims 1, 3-9, 11-13 and 15-20 have been amended. Applicants respectfully request consideration of the present application in view of the foregoing amendments and the following remarks. No new matter has been added.

Support for Claim Amendments

Support for independent claims 1, 13, 21 & 22 can be found throughout the specification. In particular, the specification teaches embodiments where the pool of test takers, from which candidates for the claimed process for admissions are identified. *See, e.g.,* Application p. 12, ln. 15-18. The specification also teaches the use of a computer program product that enables implementation of the methods described in the specification. *See, e.g.,* Application p. 17, ln. 28 – p. 18, ln. 6. Remaining amendments are minor, such as, to insure that the claim language is consistent with the claims on which they depend. Accordingly, no new matter is introduced by the current claim amendments.

In the Office Action, claims 1-12 were rejected under 35 U.S.C. §112 first paragraph as failing to comply with enablement requirement. The Examiner is unable to identify how the Applicant intends to find out which students have applied to other schools and have not received offers. Applicant has deleted the offending language as it does not go to the heart of novelty. The simple fact is that the candidates apply to Applicants program when they have not received offers from another institution. The program is directed to giving candidates a chance to show their abilities through a carefully developed program whereas such candidates have not been able to achieve appropriately high scores for admission to other academic institutions.

By the amendment to claim 1 and the elimination of the phrase "but have not received an offer for admission" it is believed that the 35 U.S.C. §112 objection is obviated.

The Examiner has also rejected claims 3 and 11 under 35 U.S.C. §112 as being indefinite as the claims have the limitation of "combining scores for said at least one "examination", said

combined scores forming a composite score". Examiner notes that she is unable to identity how one would combine scores when there is only one test score. Examiner then notes that an enrolled student has already been admitted to the university as set forth in claim 1, therefore if they are enrolled they cannot be part of a "program for admissions".

Applicant will again attempt to deal with this last point to the satisfaction of the Examiner. Through prior responses and through an actual interview where the inventor and attorney met with the Examiner and her supervisor at the patent office, Applicant has steadfastly maintained that the student is not enrolled in the university at the time that they are in the "program for admissions", and believes that the language of the specification and the language of the claims is clear on this point. However, Applicant surmises that it is the word "enroll" which is confusing this issue and accordingly, Applicant has removed "enroll" from all claim language. Applicant has stressed repeatedly that any enrollment language is directed to enrollment in the program for admission and not into the institution. In any event, Applicant hopes that the present amendment clarifies this issue.

With respect to the Examiner's objection of claim 3, the Examiner says she is unable to identify how Applicant would combine scores when there is only one test score. Applicant did not claim one examination but "at least one examination". Applicant is entitled to such a range and if there are multiple exams given then scoring will occur on a calibrated grading process to calculate a composite score.

Claim Rejections Under 35 U.S.C. §102(b)

Claims 1, 13 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by www.gradcollege.swt.edu (hereafter "Grad College"). The Applicant respectfully submits that the prior art does not teach the method of the amended claims.

Grad College is directed to the well known practice of conditionally admitting students *who have applied to a university*. The students selected for conditional admission in Grad College are those who were close to meeting the standardized test and G.P.A. guidelines used for admission to the university, i.e. they had "borderline credentials." Alternately, the conditionally admitted students may have met one of the admission requirements, but not others.

As noted above, Applicants program does not conditionally admit students to the university. Applicants program clearly distinguishes Grad College because its process is strictly an admissions office program. The selected candidates are permitted to take an abbreviated academic program through the admissions office administration, with the sole purpose of showing they have the ability to perform at an acceptable academic level and should be admitted to the university. This concept is totally different from Grad College or any of the prior art which the Examiner has cited or of which Applicant is aware of.

If the Applicant successfully scores at a sufficient level in the admissions process, then that Applicant can be admitted to the institution if he or she so chooses. No credit is given for the abbreviated program that is part of the admissions process, however, the student has achieved the objective of being admitted to an accredited institution.

Further, as amended Claims 1, 13, and 20 all recite that the pool from which test takers who participate in the program for admissions are chosen, includes test takers that *did not initially apply to that particular academic institution.* Unlike Grad College, or any other conditional admissions program the Applicant is aware of, *see* Affidavit of Philip D. Shelton, the method of the present invention can enable a student that *never filed a formal application* to a particular academic institution to gain admission to that academic institution. See, e.g. Application, p. 12, ln. 15-18. Clearly, this element is not taught by Grad College. Accordingly, the Applicant submits that these amended claims present allowable subject matter.

Another distinction between the conditional admissions programs cited in the Office Action and the present claims, is that the present claims can result in the admission of test takers with less than borderline credentials. By identifying those students who were not accepted by any academic institutions, the test takers that are offered a spot in the program for admissions are typically those having poor standardized test scores and G.P.A.s. It is common that the test takers identified by the identification step have such low test scores and G.P.A.s that they would not have borderline credentials for any academic institutions to which they applied. This aspect of the present claims is so atypical that Philip D. Shelton, CEO of the Law School Admissions Counsel, the body that administers the LSAT, *has not heard of any school requesting a similar search. See* Affidavit of Phillip Shelton. Clearly, this element is not taught by Grad College. Accordingly, the Applicant submits that these amended claims present allowable subject matter.

For at least the reasons given above, Applicant respectfully submits that claims 1, 13, and 20 are allowable over the prior art of record.

Claim Rejections Under 35 U.S.C. §103 (a)

A prima facie case of obviousness requires (1) a motivation or suggestion to combine the teachings of the references, (2) a reasonable expectation of success, and (3) that the prior art references *must teach or suggest all the claim limitations*. *See* MPEP §2143. An obviousness rejection cannot be sustained if any of these elements is not established or the applicant can rebut any of the elements. As discussed above, Grad College does not teach offering an admissions program as opposed to a conditional admission into the institution; offering an admissions program to students who did not initially apply to the institution; or offering an admissions program to students who did not submit credentials that were, at least, borderline. In fact, none of the cited art teaches or suggests these elements of the present claims. Claims 2-12 & 14-19, which depend on claims 1 & 13, present patentable subject matter as set forth above and because of features recited therein. The Applicant asserts that since claims 21 & 22 contain both elements set forth above and additional features, these claims also present patentable subject matter.

Secondary considerations, such as the failure of others and long-felt but unresolved needs, are considered as indicia of nonobviousness. *See* MPEP §716.01(a). Philip D. Shelton, President of the LSAC, the group that administers the LSAT, states that the LSAT is the best standardized admission test in the admission testing industry. *See* Affidavit of Philip D. Shelton. The score a test taker achieves on the LSAT, while representing a bell curve centered on that value, is indicative of the most likely level of performance. Thus, like all bell curves, a significant percentage will perform better than mode, i.e. the score the test taker received. As acknowledged by Mr. Shelton, even after extensive research, the LSAC has been unable to identify a single variable or combination of variables that will identify test takers who will significantly outperform test takers with much higher scores. *See* Affidavit of Philip D. Shelton. Clearly, a method to identify these high-performing, low-scoring test takers is a long-felt but unmet need in the field of law school admissions. Equally clearly, others have attempted unsuccessfully to address this need. The claimed methods successfully addresses this long-felt,

but unmet need. *See* Affidavit of Philip D. Shelton. Further, the program incorporating the claimed methods has achieved commercial success and has been licensed to other academic institutions, evidencing that the claimed methods fulfill this long-felt need. An affidavit evidencing the commercial success was filed in response to the previous Office Action. Both of these secondary factors argue strongly against obviousness in the present case. *See* MPEP §716.04. Accordingly, the Applicant respectfully submits that the combinations suggested in the Office Action are not obvious.

As noted above, the LSAT is the best standardized admissions test in the industry. Thus, if the LSAT cannot identify these high-performing, low-scoring test takers, neither can the MCAT, DAT, VCAT, PCAT, AHPAT, GRE, or the GMAT. In fact, the need for the method of the present claims would be even greater for these other admissions tests. Accordingly, it is respectfully submitted that the combinations suggested in the Office Action are not obvious.

For at least the reasons given above, Applicants respectfully submit that all claims in the present Application present patentable subject matter.

Claim 22 stands rejected under 35 U.S.C. §103 (a) as being unpatentable over Grad College in view of U.S. Patent No. 6,088,686 to Walker et al. (hereafter "Walker"). This rejection is respectfully traversed.

As with Grad College, Walker does not teach or suggest that a particular academic institution's program for admissions consider admitting a test taker who is a non-applicant or who, according to the test taker's G.P.A. and standardized test scores, has less than borderline credentials for a particular academic institution. Rather, Walker is directed to an on-line application process for identifying individuals who have applied to a particular institution that are *well qualified* according to the information provided along with the application. Clearly, Walker does not teach or suggest a program for admissions that admits non-applicants. Furthermore, Walker does not teach or suggest admitting individuals whose application information indicates they are poorly suited for admission. Accordingly, since the combination of Grad College and Walker fails to teach or suggest each element of the Applicant's claimed invention, a prima facie case of obviousness can not be made with the cited art. *See* MPEP §2143.

As set forth above, none of the pending claims are taught or suggested by the cited art. Accordingly, the Applicant respectfully submits that all pending claims are in condition for allowance.

Conclusion

For at least the reasons given above, Applicant submits that claims 1-22 define patentable subject matter and are in condition for allowance. Accordingly, Applicant respectfully requests allowance of these claims. The foregoing is submitted as a full and complete Response to the Office Action mailed November 4, 2005, and early and favorable consideration of the claims is requested. Should the Examiner believe that anything further is necessary in order to place the application in better condition for allowance, the Examiner is respectfully requested to contact Applicant's representative at the telephone number listed below. No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 50-0951.

Respectfully submitted,

Date: 5/3/06

J. Rodman Steele, Jr.
Registration No. 25,931
Mark D. Passler
Registration No. 40,764
AKERMAN SENTERFITT
Post Office Box 3188
West Palm Beach, FL 33402-3188
Telephone: (561) 653-5000